

Attachment to Form PTO/SB/33 Pre-appeal Request for Review

Reasons for Review

Review and withdrawal of the final rejections is sought since the Examiner has failed to give proper weight to declaration evidence that was presented and her positions are inconsistent with Office policy as set forth in the MPEP and appropriate case law.

In particular, a Declaration of Roland Hölzl (hereafter, the "Declaration"), the inventor of the U.S. Patent No. 5,026,998 which the Examiner relied upon in her rejections under § 103 was submitted which provides factual evidence that directly refutes the assumptions and conclusions expressed by the Examiner and explains why the invention is not obvious in view of his patent and the acknowledged commercially available optoelectronic sensors as well as why one of ordinary skill in the art would both be able to make and use the claimed invention based on his/her knowledge and the original disclosure of the present application and would recognize that the present inventor was in possession of the invention recited in the claims. However, the Examiner has failed to given due weight to this evidence and continues to relied on her opinions rather than the facts established by declaration.

The Examiner has rejected the claims under 35 USC § 112, first paragraph with respect to both the written description requirement and the enablement requirement. In refusing to act the Declarant's statements, the Examiner has expressed positions that do not reflect the proper standard for determining what constitutes new matter and compliance with the enablement and written description requirements, the following is noted.

As noted by the Examiner, to satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. It has been held that there is no *in haec verba* requirement for literal use of the claim language, and that it is sufficient that newly added claim limitations be supported in the specification through express, implicit, or inherent disclosure. Furthermore, it is stated in MPEP § 2163III(a) that:

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence

why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:

(A) Identify the claim limitation at issue; and

(B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description.

In the present case, the Examiner has failed to establish facts that demonstrate the specification does not describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention without any explanation of the type required as to why that is the case. On the other hand, section 4 of the Declaration contains, in the first paragraph of that section, a statement by one of ordinary skill in that art that the specification "reflects the fact that The Inventor was in possession of the invention recited in The Claims," and then, in the following paragraphs of that section explains in detail why. Thus, in the absence of facts, not opinion, which rebut the facts established by the declarant, the rejection based upon the written description requirement must be withdrawn.

The claims were also rejected under 35 U.S.C. 112, first paragraph as being based on a non-enabling disclosure. However, the same section 4 of the Declaration clearly establishes that one of ordinary skill in the art would know how to make and use the invention, both with respect to the known location recitations and how to measure and evaluate the relative position of two elements with respect to each other. As pointed out in MPEP § 2164.05, a "declaration or affidavit is, itself, evidence that must be considered The examiner should **never** make the determination based on personal opinion" (emphasis in original). Still further, MPEP § 21604.08 points out that the Federal Circuit has held that "[a]ll that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. Further the scope of enablement must only bear a "reasonable correlation" to the scope of the claims. See, e.g., *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970)." Here, the declarant has explained why/how one of ordinary skill in art would be able to practice the claimed invention given the disclosure of

the Lysen patent (USP 6,337,742), the fact that “the primary difference between the device described in the Hermann Application and that described in the Lysen Patent is that the beam splitter 22 of the Lysen Patent is eliminated and the reflectivity of sensor 110 of the Hermann Application is utilized instead,” and that the reference in paragraph [0026] of the specification to the fact that the invention “is ‘especially suited’ for use in the position detection system of “German Patent Application DE 19733919 and U.S. Patent 6,049,378” (which the Examiner evidently does not contend is invalid for lack of an enabling disclosure) is a clear disclosure that techniques for measuring or evaluating the relative position of two elements with respect to each other of the Lysen Patent apply to the invention of the Hermann Application.” The Examiner’s comments indicate that her rejection is based on the lack of explicit statements, but no such requirement exists in the law. To the contrary, specifications are written to the level of ordinary skill in the art. Thus, the Examiner’s reference in item (2) spanning pages 2 & 3 of the final rejection to those items which are not mentioned in the specification is irrelevant given that the declarant has stated these factors to be among those items known to one of ordinary skill. The Examiner lacks the authority to simply refute factual evidence without demonstrating that the facts are incorrect and are outside of what was known in the art.

The claims have also been objected as being confusing and indefinite; however, these objections are in reality a rejection under 35 USC § 112 and should be treated as such. The Examiner should not be permitted to circumvent applicant’s right to appeal what is actually a rejection for indefiniteness under 35 USC § 112 by calling it an objection. Here, the Examiner has merely conjectured reasons why one might find the claims indefinite, but provides no evidence which would indicate that such views would be considered problems by one working in this field when the Declarant states that such is not the case for specific reasons..

Turning now to the Examiner’s rejection of claims 1, 3 and 4 under 35 U.S.C. 103(a) as being unpatentable over the Holzl ‘998 patent when viewed in conjunction with applicant’s admitted prior art, in addition to the prior declaration evidence supporting applicant’s view that this repeated rejection is totally inappropriate, any vitality that the Examiner’s rejection may have had has been completely eliminated by the evidence presented by the Declaration of the very inventor whose patent the Examiner has relied upon to support her position that the claimed invention is obvious. The Examiner simply cannot rely upon her opinion as to what one of ordinary skill in the art would have found to be

obvious when the patentee of the patent she is relying upon presents declaration evidence that clearly and unequivocally establishes that the invention would not have been obvious from anything that he taught when considered in combination with that which was known to those of ordinary skill in the art. In this regard, the Panel's attention is directed to paragraphs 3 & 5 of the Declaration, which states in part:

... at that the time of that the Hermann Application was filed, I and others in the field considered the reflectivity of the sensors to be a problem which had to be minimized or eliminated ... and I know of no one that considered the reflectivity of the optoelectronic sensors to be a usable feature prior to that discovery by Mr. Michael Hermann....

... there is simply no basis for the Examiner's conclusion that it would have been obvious to use the reflective properties of the commercially available optoelectronic sensors ... there is simply no factual basis for the Examiner's conclusion that it would be "an obvious matter of design choice" to make the **structural** changes necessary to go from ... the very different method and apparatus of My Patent to that of the Hermann Application.

Not only is the Examiner's conclusions of obviousness erroneous, but they have been arrived at using an improper standard of obviousness that is contrary to the law without given consideration to the changes which would be needed to arrive at the present invention from what was known in the prior art, since more than a mere change of one sensor for another is required. Thus, the Examiner has not made the factual determinations set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 48 (Supreme Court 1966), which require not only an assessment of the scope and content of the prior art but also of the differences between the prior art and the claims in issue. The mere statement that something was known and an "obvious design choice" without some factual evidence that refutes factual Declaration evidence that establishes not only that the known sensors were not used in manner purported to be obvious by the Examiner, but in fact standard practice teaches away from what the Examiner has considered to be obvious.

For example, the Examiner has failed to indicated where it is taught or suggested by the AAPA (or Holzl) that the reflective capabilities of the surface of a first optoelectronic sensor can be utilized in a two-sensor position determination system when the declarant states that such was unknown at the time that the present invention was made. The AAPA cannot be relied upon for such evidence since it is merely a statement that the present applicant found a known sensor which will serve the needs of the claimed invention, not that this fact was known prior to his discovery. It is incumbent upon the Examiner, in the face of the

Declaration, to provide some evidence which refutes the Declaration statement and demonstrates that someone other than this applicant recognized that the reflectance possessed by the known optoelectronic sensors was anything other than a detriment and could be used to provide accurate position determinations in combination with a second optoelectronic sensor in the manner of the present invention. In this regard, the previously submitted evidence of the results of a search of the USPTO patent database that revealed more than 1000 patents which disclose such anti-reflectance coatings for optoelectronic sensors clearly demonstrates that one of ordinary skill in the art considered the reflective characteristics of the surface of an optoelectronic sensor to an undesirable feature (as evidenced by the common use of anti-reflection coatings on such sensors and corroborating that which is attested to in the Declaration). The Examiner has repeatedly refused to address this fact and it is submitted that this failure renders the rejection fatally defective in the face of the evidence presented.

The Examiner has also made no attempt to refute the evidence provided which also included the fact that the devices of the referenced U.S. Patents 6,337,742 and 6,476,914 (which are more recent than that of the Hölz patent relied upon by the Examiner) found it necessary to use mirrors and prism instead of the reflective capacity of the sensors, further indicating that it was unknown that the reflective properties of known sensors could be used and need not be counteracted. In this regard, it is pointed out that the Federal Circuit has held that proceeding contrary to accepted wisdom in the art, as has been done to achieve the present invention, is evidence of nonobviousness. *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (1986).

Therefore, in light of the deficiencies in the Examiner's assessment commented upon above, even if an initial *prima facie* case of obviousness had been established by the combination of the teachings of Holzl and AAPA, it has been overwhelmingly rebutted so that the rejection of claims 1, 3 and 4, under § 103(a), is improper and should now be reversed.